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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,344	02/24/2004	Kirk D. Swenson	3896-040075 (P-5973)	8737
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David W. Highet, VP & Chief IP Counsel Becton, Dickinson and Company (The Webb Firm) 1 Becton Drive, MC 110 Franklin Lakes, NJ 07414-1880				
EXAMINER				
HANDY, DWAYNE K				
ART UNIT		PAPER NUMBER		
1797				
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02/05/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/785,344

Applicant(s)

SWENSON, KIRK D.

Examiner

DWAYNE K. HANDY

Art Unit

1797

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-32 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8, 10-18 and 33-40 is/are rejected.
- 7) ☒ Claim(s) 4, 9 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-3, 5-8, 10-18 and 33-40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,651,835. Although the conflicting claims are not identical, they are not patentably distinct from each other. This rejection was applied in the previous Office Action (mailed 6/27/08). It remains in effect. The Examiner notes Applicant's desire to further address this rejection upon the indication of otherwise allowable subject matter. See page 9 of Applicant's Arguments, submitted 10/27/08.

Claim Rejections - 35 USC § 102

Claim Rejections - 35 USC § 103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-3, 5-7, 10-18 and 33-40 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Iskra (US 2002/0011492). This rejection was applied in the previous Office Action. It remains in effect.

Response to Arguments

5. Applicant's arguments filed 10/27/08 have been fully considered but they are not persuasive. Applicant has argued that Iskra does not teach a venting pathway that is a combination of a textured surface area and a longitudinal groove. The Examiner respectfully disagrees. The Examiner has taken the position that the roughened surface of Iskra includes both a textured surface and a longitudinal groove. That is, the roughened surface anticipates the limitation of "a combination of a textured surface area and a longitudinal groove". The rationale for this rejection was given in Paragraph 6 of the previous Office Action. The passage cited by Applicant recites that the roughened surface contains "peaks and valleys" and that the valleys define "circuitous paths". The Examiner considers these valleys to be "longitudinal grooves" that are located within the roughened surface area. Therefore, the roughened area alone of Iskra meets the limitation of "a combination of a textured surface area and a longitudinal groove". The Examiner also included a 103 alternative rejection based on the shape of the path or groove (i.e. circuitous vs. longitudinal) and the Examiner's assertion that the term "longitudinal" does not necessarily require that the groove be straight, but that the difference in shape would be obvious to one of ordinary skill in the art.

6. Applicant has further argued that Iskra teaches away from a longitudinal groove based on a passage which notes that longitudinal grooves are not required to achieve efficient nesting (Applicant's Arguments, page 12). The Examiner notes the passage

cited Applicant but also directs Applicant to previous Paragraphs [0008] which shows that Iskra is referring to prior art containers having longitudinal grooves "along the length of the outer surface of the inner container and or along the length of the inner surface of the container. The grooves permit air to escape during assembly of the containers". The Examiner submits that the passages directed to the groove, taken in their entirety, simply teach away from a groove that runs the length of the tube surface. These passages, however, do not change the fact that Iskra discloses a roughened surface having peaks and valleys as discussed above.

The Examiner does concede that these passages may constitute a teaching away of the use of a longitudinal groove ***in addition to the roughened surface and outside the roughened surface portion***. It is for this reason that claims 4 and 19 have been cited as containing allowable subject matter. Claims 4 and 19 recite a longitudinal groove that extends from adjacent the bottom of the inner tube towards the open top of the inner tube to a location adjacent the textured surface. This limitation clearly places the longitudinal groove of the instant device outside of the textured surface area. Iskra, based on the passages cited by Applicant and the Examiner, does not teach nor suggest a longitudinal groove that is located outside the roughened area already provided.

Allowable Subject Matter

7. Claims 20-32 are allowed.

8. Claims 4, 9 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **DWAYNE K. HANDY** whose telephone number is (571)272-1259. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dwayne K Handy/
Examiner, Art Unit 1797
February 2, 2009

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1797